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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,480	11/20/2001	Indulis Gruzins	102123-200	3615

7590 04/23/2007  
Docket Coordinator  
WIGGIN & DANA, LLP  
One Century Tower  
265 Church Street  
New Haven, CT 06508-1832

EXAMINER
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OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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04/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/996,480	<b>Applicant(s)</b> GRUZINS ET AL.	
	<b>Examiner</b> Taylor Victor Oh	<b>Art Unit</b> 1625	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: \_\_\_\_\_.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see pages 2-6.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

It is noted that applicants have filed an Amendment after the Final Rejection on 04/03/07; applicants' attorney has addressed the issues of record. The proposed amendment will be entered; however, it is not in a condition for allowance.

**The Status of Claims**

Claims 1-25 and 27-31 are pending.

Claims 1-25 and 27-31 are rejected.

**Claim Rejections-35 USC 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claim 14 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the modification made in the claims in the amendment.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**The rejection of Claims 1-25 and 27-31 under 35 U.S.C. 103(a) as being unpatentable over Housel et al (U.S. 6,103,822) in view of Koistinen et al (WO 98/50338) .**

The rejection of Claims 1-25 and 27-31 under 35 U.S.C. 103(a) as being unpatentable over Housel et al (U.S. 6,103,822) in view of Koistinen et al (WO 98/50338) has been maintained with reasons of record on 1/23/06.

Applicants' attorney has addressed the issues of record, but not rebutted the claim rejections *1-25 and 27-31* under 35 USC 103 (a).

**Applicants' Argument**

1. Housel does not suggest or disclose any catalyst other than an organometallic catalyst, such as organotin except that Housel discloses the use of any catalyst as an optional one;
2. There is no motivation to combine the Housel with Koistinen et al since Koistinen et al has disclosed only the tin oxide catalyst employed in examples of 1-3 and 5-31 and Housel discloses tin oxide catalyst to be used in the disclosure; in addition, even if one of ordinary skill in the art looked to Koistinen et al to modify Housel et al, tin oxide would be used as a catalyst since tin oxide was specified as the catalyst utilized in all of Koistinen et al's working examples; and

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3. The specific amount of acid catalyst in the Koistinen et al is from 500 to 5000 ppm (0.05 to 0.5 %) (see page 3 ,lines 16-18) and Housel et al discloses a specific amount of acid catalyst from 0 to 30,000 ppm ; none of them suggest the instantly claimed range of 5 to 500 ppm.

First, with respect to the first, the second and third arguments argument, the Examiner has noted applicants' argument. However, the Housel prior art does teach not only organotin as a catalyst , but also the use of "catalysts" in general (see col. 8 ,line 1) in the process ; in addition, Housel et al does describe the polymeric acid functional polyol which is the reaction product of polyols and the acid anhydride in the presence of tin metal oxide catalysts (see col. 13 ,lines 19-21) in an amount of from 0 to 30,000 ppm (see col. 13 ,lines 22-24) for the purpose of controlling the reaction.

Furthermore, Koistinen et al expressly teaches the use of " a catalyst" in general (see an abstract page) and a catalyst , such as sulfuric acid, hydrochloric acid or metal oxides, such as titanates or tin oxides (see page 3 , lines 17-18) in the amount of from 0.05 to 0.5 % (500 to 5000 ppm )of the reacting components (see page 3 ,lines 16-18).

In addition, regardless of the only tin oxide catalyst utilized in all of Koistinen et al's working examples, the fact remains still unchanged; namely, the qualification of information as the prior art does not depend on where it is located or how it is located, but it depends on the fact that whether or not it truly teaches the claimed limitation. In the instant case, the secondary prior art, Koistinen et al, does specify the claimed limitation as disclosed in the use of the

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following catalyst: sulfuric acid, hydrochloric acid or metal oxides, such as titanates or tin oxides (see page 3 , lines 17-18). From this, the Koistinen et al does offer guidance that there is an equivalence of teaching regarding the use of the catalyst between the hydrochloric acid and tin oxides(see page 3 , lines 17-18). Therefore, there is a motivation to combine the prior art. Furthermore, both prior art processes have commonly dealt with the production of carboxy-containing polyol composition with similar reaction conditions (i.e. reactants). Therefore, it would have been obvious to the skillful artisan in the art to be motivated to employ Koistinen's et al hydrochloric acid into the Housel et al process as an alternative to the Housel's et al tin oxide because the skilled artisan in the art would expect such a modification to be successful and effective as guidance shown in Koistinen et al .

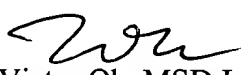
Moreover, both prior art expressly teach the amount of the catalyst (0 to 30,000 ppm or 500 to 5000 ppm), which is overlapped with or is included within the claimed range ( 5 to 500 ppm). Therefore, they still read on the claimed invention unless the claimed ranges produce unexpected results. Thus, applicants' argument are not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Taylor Victor Oh, MSD, LAC  
Primary Examiner  
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4/17/07